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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,968	10/02/2003	Kikuo Yamaguchi	402808	6292

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LEYDIG VOIT & MAYER, LTD
700 THIRTEENTH ST. NW
SUITE 300
WASHINGTON, DC 20005-3960

EXAMINER

LERNER, AVRAHAM H

ART UNIT PAPER NUMBER

3611

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/675,968

Applicant(s)

YAMAGUCHI, KIKUO

Examiner

Avraham Lerner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5 is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 6-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The substitute drawings were received on September 3, 2004. These drawings are accepted.

Claim Objections

2. Claims 3 and 8 are objected to because of the following informalities: each is dependent on claim 2, which has been canceled. Although the claims may be withdrawn from consideration for being of improper dependency, as best understood the examiner will treat claim 3 as depending from claim 1, and claim 8 as depending from claim 3.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 6 recites the limitation "the first opening" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. The subject matter recited in claim 6 is entirely unclear in scope and structure and can not be treated on its merits in that there is no antecedent basis for the elements, and further because applicant's identification of the first, second, and third prongs is inconsistent.

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6. Claim 7 recites the limitation “the first base” in lines 1-2, and “the second base” in line 2. There is insufficient antecedent basis for these limitations in the claim.

7. Claim 8 recites the limitation “the first base” in lines 1-2, and “the second base” in line 2. There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 3, 4, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Mortimer (U.S. Patent No. 6,099,012).

Mortimer discloses an apparatus having all elements as broadly claimed, including a first prong (vertical section labeled 58 in Fig. 3) capable of retaining a plate spring, and second and third prongs (the two vertical side sections of horizontal channel 62), the apparatus having a first plate (58) having the first prong and a second plate (horizontal channel) having the second and third prongs, the first and second plates being connected to each other (by diagonal channel 60), and are also transverse to each other, Note that regarding the broad language that the attachment is “for insertion” or “for retaining a plate spring”, it is noted that “the absence of a disclosure relating to function does not defeat the finding of anticipation. It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable.” See *In re Schreiber* (CAFC) 44 USPQ2d 1429. This functional language has not been given patentable weight because it is narrative in form. In order to be given patentable weight, a

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functional recitation must be expressed as a “means” for performing the specified function, as set forth in 35 U.S.C. 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. See *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Allowable Subject Matter

10. Claim 5 is allowed.

Response to Arguments

11. Applicant's arguments filed September 3, 2004 have been fully considered but they are not persuasive. Applicant solely argues that the application describes an attachment for a towing apparatus, and that Mortimer does not describe or suggest the vehicle towing apparatus defined by the claims. In response, it is noted (as written above and in the previous Office action) that the vehicle and associated structure is not positively recited, but is merely an intended use for the claimed attachment. Mortimer teaches all of the positively recited structure as claimed, and in order to meet the criteria of anticipation of functional limitations, merely requires the ability to so perform. Mortimer therefore does anticipate all of applicant's claimed limitations, and the rejection is sustained.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avraham Lerner whose telephone number is (703) 308-0423. The examiner can normally be reached on M-F (8:15-5:45) first Wednesday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AVRAHAM LERNER
PRIMARY EXAMINER

A. Lerner 12/6/04

December 6, 2004